

In the United States Patent and Trademark Office

Appellants: Ronald L. Edens; James J. Hlaban; Docket No.: 17707
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Serial No.: 10/038,970 Group: 3761
Filed: December 31, 2001 Examiner: Anderson, Catharine L.
For: LABIAL PAD HAVING A TAB Date: November 9, 2004

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Appeal Brief Transmittal Letter

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Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. 41.37, transmitted herewith is an Appeal Brief pursuant to the Notice of Appeal which was mailed on October 11, 2004.

Please charge the \$340.00 fee, pursuant to 37 C.F.R. 41.20(b)(2), which is due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875. This Appeal Brief Transmittal Letter is submitted in duplicate.

Respectfully submitted,

RONALD L. EDENS ET AL..

By: 

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Registration No.: 29,460

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306 on November 9, 2004

By: 

Judith M. Anderson

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Appeal Brief

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Ronald L. Edens et al.
Serial No.: 10/038,970
Confirmation No. 9623
Filed: December 31, 2001
For: LABIAL PAD HAVING A TAB

Examiner: Anderson, Catharine L.
Group: 3761
Docket No.: 17,707
Date: November 9, 2004

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is filed in response to the Final Rejection having a mailing date of 07/29/2004 for the above-identified application. A Notice of Appeal was filed October 11, 2004.

REAL PARTY IN INTEREST

The real party in interest is Kimberly-Clark Worldwide, Inc., the assignee of all rights to the invention of the above-identified application.

RELATED APPEALS AND INTERFERENCES

To the knowledge of appellant, appellant's legal representative, or assignee, there are no other known related appeals or Interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1, 3-12, 14-24 and 26-36 are pending in the application.

Claims 4, 13 and 25 have been canceled.

Claims 1, 3-12, 14-24 and 26-36 are under appeal.

STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION

No amendments were filed subsequent to the Final Rejection.

SUMMARY OF THE INVENTION

The invention of independent Claim 1 provides a distinctive absorbent article (40) comprising a fluid permeable cover (62), a liquid impermeable baffle (64) and an absorbent (66) situated between the cover and the baffle. The absorbent article is configured to provide a labial pad for disposition within the vestibule of a female wearer, and the absorbent article further comprises a principal longitudinal axis, a principal transverse axis, a body-facing surface, a surface opposed to the body-facing surface, a length, a width, a thickness, first (76) and second (78) longitudinally spaced apart transverse end areas, first (80) and second (82) spaced apart longitudinal sides, with the longitudinal sides ranging between the transverse end areas and collectively defining a periphery of the absorbent article. At least one tab (94) extends outward from the periphery of each of said first and second transverse end areas (76, 78). Particular disclosure can, for example be found in the original specification at page 2, lines 22-31; and Figures 6 and 12-19. The article is shorter along its principal transverse axis than along its principal longitudinal axis (e.g. FIGs. 6-7), and the article is configured to be folded along an axis positioned parallel to said principal transverse axis prior to disposition within the vestibule of the female wearer, the folding providing a recess that protects the wearer's finger(s) from soiling when the article is disposed in the vestibule (e.g. page 14, lines 19-23). The absorbent (66) has a maximum width (W_{max}) which is no greater than about 70 mm (e.g. page 6, lines 18-21), and has a maximum length (L_{max}) which is no greater than about 100 mm (e.g. page 6, lines 32-35). Each tab (94) has a length (l) which is no greater than about 70 mm, and no greater than about 100 % of the maximum width (W_{max}) of the absorbent (66). Each said tab (94) has a width (w) which is no greater than about 50 mm; and each tab thereby has sufficient dimensions to allow a user to grasp the tabs and fold said article along the principal transverse axis prior to disposition within the vestibule of the female wearer (e.g. page 16, lines 1-28; and original Figures 8 through 11).

The invention of independent Claim 12 provides an absorbent article (40) comprising a liquid impermeable baffle (64) and an absorbent (66), the absorbent article being configured for disposition within the vestibule of a female wearer. The absorbent article further comprises a principal longitudinal axis, a principal transverse axis, a body-facing surface, a surface opposed to the body-facing surface, a length, a width, a thickness, first (76) and second (78)

longitudinally spaced apart transverse end areas, first (80) and second (82) spaced apart longitudinal sides, with the longitudinal sides ranging between the transverse end areas and collectively defining a periphery of the absorbent article. At least one tab (94) extends outward from the periphery of each of the first and second transverse end areas (76, 78). Particular disclosure can, for example be found in the original specification at page 2, line 32 through page 3, line 3; and Figures 6 and 12-19. The article is shorter along its principal transverse axis than along its principal longitudinal axis (e.g. FIGs. 6-7), and the article is configured to be folded along an axis positioned parallel to said principal transverse axis prior to disposition within the vestibule of the female wearer, with the folding providing a recess that protects the wearer's finger(s) from soiling when the article is disposed in the vestibule (e.g. page 14, lines 19-23). The absorbent (66) has a maximum width (W_{max}) which is no greater than about 70 mm (e.g. page 6, lines 18-21), and has a maximum length (L_{max}) which is no greater than about 100 mm (e.g. page 6, lines 32-35). Each said tab (94) has a length (l) which is no greater than about 70 mm, and no greater than about 100 % of the maximum width (W_{max}) of the absorbent (66). Each said tab (94) has a width (w) which is no greater than about 50 mm; and each tab thereby has sufficient dimensions to allow a user to grasp the tabs and fold said article along the axis positioned parallel to said principal transverse axis prior to disposition within the vestibule of the female wearer (e.g. page 16, lines 1-28; and original Figures 8 through 11).

The Invention of independent Claim 24 provides an absorbent article (40) comprising an absorbent (66), the absorbent article being configured for disposition within the vestibule of a female wearer. The absorbent article further has a principal longitudinal axis, a principal transverse axis, a body-facing surface, a surface opposed to the body-facing surface, a length, a width, a thickness, first (76) and second (78) longitudinally spaced apart transverse end areas, first (80) and second (82) spaced apart longitudinal sides, with the longitudinal sides ranging between the transverse end areas and collectively defining a periphery of the absorbent article. At least one tab (94) extends outward from the periphery each of said first and second transverse end areas (76, 78). Particular disclosure can, for example, be found in the original specification at page 3, lines 6-13; and Figures 6 and 12-19. The article is shorter along its principal transverse axis than along its principal longitudinal axis (e.g. FIGs. 6-7), and the article is configured to be folded along an axis positioned parallel to the principal transverse axis prior to disposition within the vestibule of the female wearer, with the folding providing a recess that protects the wearer's finger(s) from soiling when the article is disposed in the vestibule (e.g. page 14, lines 19-23). The absorbent (66) has a maximum width (W_{max}) which is no greater

than about 70 mm (e.g. page 6, lines 18-21), and has a maximum length (L_{\max}) which is no greater than about 100 mm (e.g. page 6, lines 32-35). Each said tab (94) has a length (l) which is no greater than about 70 mm, and no greater than about 100 % of the maximum width (W_{\max}) of the absorbent (66). Each tab (94) has a width (w) which is no greater than about 50 mm; and each tab thereby has sufficient dimensions to allow a user to grasp the tabs and fold said article along the axis positioned parallel to said principal transverse axis prior to disposition within the vestibule of the female wearer (e.g. page 16, lines 1-28; and original Figures 8 through 11).

GROUND OF REJECTION PRESENTED FOR REVIEW

Grounds 1

Claims 1, 3-12, 14-24 and 26-36 have been deemed unpatentable over U.S.P. 6,613,031 to Glasgow et al., under 35 U.S.C. §103(a).

Grounds 2

Claims 4, 7, 16, 19, 28 and 31 have been deemed unpatentable over U.S.P. 6,613,031 to Glasgow et al. in view of U.S.P. 5,713,886 to Sturino, under 35 U.S.C. §103(a).

Grounds 3

Claims 6, 8, 11, 18, 20, 23, 30 32 and 36 have been deemed unpatentable over U.S.P. 6,613,031 to Glasgow et al., as applied to claims 1, 12 and 24, in view of U.S.P. 5,509,914 to Osborn III, under 35 U.S.C. §103(a).

ARGUMENTS FOR REVERSAL

The claims on appeal

Claims 1, 3-12, 14-24 and 26-36 are on appeal, and are set forth in the enclosed APPENDIX 1.

Prior art relied on by the Examiner

In the Final Rejection, the Examiner has relied on the following art:

U.S.P. 6,613,031 to Glasgow et al.

U.S.P. 5,713,886 to Sturino

U.S.P. 5,509,914 to Osborn III

Arguments

For the reasons set forth below, Appellants respectfully submit that the Examiner's rejection should be reversed. It is also respectfully submitted that for the reasons set forth below, the claims do not stand or fall together.

It is respectfully submitted that the Examiner's rejections under 35 U.S.C. §103, based on the teachings of the cited references are not proper, and that the teachings of the cited references do not render obvious a structure having the combination of components called for by Appellants' claimed invention. It is respectfully submitted that the Examiner has not established "prima facie" that a proper combination of the cited references would disclose or suggest Appellants' claimed invention.

It is well accepted that, as a minimum, a prima facie case of obviousness must contain the following elements:

- 1) there must be a basis in the reference for a modification;
- 2) there must be a reasonable expectation of success -- obvious to "try" is not the standard; and
- 3) the prior art must render obvious the invention as a whole.

In addition, it is not appropriate to engage in hindsight. It is inappropriate to pick and choose isolated elements from various prior art references and combine them so as to yield the invention in question when such combining would not have been an obvious thing to do at the time in question. Panduit Corporation v. Dennison Manufacturing Company, 227 USPQ 337 (Fed. Cir. 1985).

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. In re Fritch, 23 USPQ 2nd 1780, 1783-1784 (Fed. Cir. 1992).

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 Fed. 2nd 982, 987, 18 USPQ 2d 1885, 1888 (Fed. Cir. 1991). In re Fritch, 23 USPQ 2nd 1780 at 1784 (Fed. Cir. 1992). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. In re Fine, 837 Fed. 2d at 1075, 5 USPQ 2d at 1600. In re Fritch, 23 USPQ 2nd 1780 at 1784 (Fed. Cir. 1992). Where the cited references do not teach how to make the particular combinations

needed to arrive at the invention called for by Appellants' claims, the claimed invention cannot be deemed "obvious". Ex parte Levengood, 1993.

It is also well established that a prior art reference must be evaluated as an entirety and that the prior art must be evaluated as a whole. W.L. Gore and Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983). Where neither any reference considered in its entirety, nor the prior art as a whole, suggests the combination claimed, the invention is non-obvious. Fromson v. Advance Offset Plate, Inc., 225 USPQ 26 (Fed. Cir. 1985).

In the present application, however, the cited references, when considered in their entirety, do not disclose or suggest the combination asserted by the Examiner. If anything, the references suggest that the combination asserted by the Examiner would be contrary to the desires and expectations of the person of ordinary skill. A proper combination of the cited references would provide only an expectation that the apparatus and method of the present invention would be unsuccessful. To a person of ordinary skill, the cited references would teach away from even trying the invention called for by Appellants' claims.

Grounds 1

It is respectfully submitted that Claims 1, 3-12, 14-24 and 26-36 are patentable over U.S.P. 6,613,031 to Glasgow et al. (Glasgow). Accordingly, the Examiner's rejection under 35 U.S.C. §103(a) should be reversed.

Glasgow describes a sanitary napkin having a front flap that adhesively attaches to the user's undergarment and a tail strip that extends rearwardly to reside in the user's intergluteal crevice. The pad thus fits snugly against the body of the user, and the strip provides desired body contact.

Glasgow, however, does not disclose or suggest an arrangement wherein at least one tab extends outward from the periphery of each of the first and second transverse end areas of the article, and each tab has the configuration called for by the claimed invention. In particular, Glasgow does not teach an arrangement in which each of the tabs has a length which is no greater than about 70 mm. As a result, when compared to the claimed invention, the long tail strip taught by Glasgow would be less able to be efficiently grasped by the fingers of a user's hand at locations adjacent the end edges of the absorbent, and would be less able to efficiently provide an intended folding of the article prior to disposition within the vestibule of the female wearer. Additionally, the long tail strip taught by Glasgow would undesirably increase the

likelihood that the fingers of the user's hand will come into contact with the soiled, body-facing portions of the pad or tab. The long tail strip taught by Glasgow could also excessively interfere with the desired gripping at locations adjacent the edges of the absorbent to generate the desired folding operation. The extra length of the tail strip could undesirably wrap about the user's fingers, and could cause an undesired twisting of the article that would further interfere with a folding of the article.

Recognizing that Glasgow does not anticipate Appellants' claimed invention, the Examiner's rejection has been based upon 35 U.S.C. § 103(a).

Contrary to the Examiner's assertions, however, it is submitted that Glasgow provides no motivation for making the changes needed to synthesize the configurations called for by Appellants' presented claims. To the contrary, it is readily apparent that Glasgow teaches away from Appellants' claimed invention. Glasgow clearly teaches that the positioning of the long tail strip into the intergluteal crevice is important to secure the tail end of the pad. In particular, at column 4, lines 22-26 Glasgow states:

As illustrated in FIG. 5 the intergluteal tail is placed by the wearer in her intergluteal crevice. This positioning of the tail into this area is sufficient to secure the tail end of the pad.

Glasgow also teaches that the intergluteal tail has an acceptable length of 10 to 30 cm. In particular, at column 5, lines 3-6, Glasgow states:

The tail extends 15 cm from the rear end 19 of the main pad body. A range in length from 10 to 30 cm would be acceptable. Preferably, the tail's length ranges from 12 to 18 cm.

While Glasgow teaches a raised area of the main body pad for insertion into the vagina (at column 5, lines 22-25), Glasgow does not disclose or suggest an article that is configured to be folded prior to disposition within the vestibule of the female wearer, as called for by the claimed invention. Instead, Glasgow teaches that an acceptable intergluteal tail should be quite long to reach the intergluteal region of the wearer. As a result, Glasgow clearly does not disclose or suggest a deletion of the intergluteal tail and a substitution of the distinctively configured tab arrangement called for by Appellants' currently presented claims. Glasgow provides no motivation for such a modification. Indeed, to do so would clearly defeat an essential purpose of having a tail long enough to extend into the intergluteal region to secure the positioning of the article. Accordingly, Glasgow clearly teaches away from the changes needed to synthesize Appellants' claimed invention.

As a result, when compared to the configurations called for by Appellants' presented claims, the structures taught by Glasgow would be less able to be efficiently grasped by the fingers of the user's hand to fold the labial pad and to aid in the application and removal of a labial pad. Additionally, the structures taught by Glasgow would be less able to minimize the likelihood that the user's fingers will come into contact with the soiled, body-facing portions of a labial pad. Accordingly, the configurations of the claimed invention do serve a useful purpose, and are not a mere matter of design choice.

It is submitted that the particular combinations of features that are called for by the claimed invention would **not** be apparent or "obvious" to the skilled person in view of the teachings of Glasgow. Only by using "hindsight", ignoring the specific teachings of Glasgow and by employing Appellants' disclosure as an instruction guide for picking and choosing disparate elements from a universe of possible features would the skilled person be led to the modifications needed to synthesize the configurations of the claimed invention. In the absence of Appellants' disclosure, however, the required changes would be unapparent and unobvious to the skilled person.

It is, therefore, readily apparent that Glasgow does not teach Appellants' claimed invention. Accordingly, the rejection of the claims as being unpatentable over this reference should be **reversed**.

Grounds 2

It is respectfully submitted that Claims 4, 7, 16, 19, 28 and 31 are patentable over U.S.P. 6,613,031 to Glasgow et al. (Glasgow) in view of U.S.P. 5,713,886 to Sturino (Sturino). Accordingly, the Examiner's rejection under 35 U.S.C. §103(a) should be reversed.

A description of Glasgow and a discussion of Glasgow's shortcomings have been previously presented, and are applicable to the present argument.

Sturino describes a sanitary napkin or panty liner especially for use with G-string and thong type undergarments. The panty liner includes an absorbent core having first and second portions. The opposed sides of the second portion flare continuously from the sides of the first portion so that the second portion has, at all points along its length, a transverse width greater than that of the first portion. A casing surrounds the absorbent core. One flap extends laterally from the casing adjacent the first portion of the absorbent core. Another flap extends laterally

from the casing adjacent each of the opposed sides of the second portion of the absorbent core. An adhesive strip is secured to each of the flaps for attachment to an undergarment.

Sturino, however, fails to cure the shortcomings of Glasgow. A proper combination of Glasgow and Sturino does not disclose or suggest the distinctive changes and modifications needed to synthesize the labial pad called for by Appellants' presented claims. Neither does a combination of Glasgow and Sturino disclose or suggest the changes needed to generate a configuration wherein at least one tab extends outward from the periphery of each of the first and second transverse end areas of the article, and each of the tabs has the configurations called for by the claimed invention.

As a result, a proper combination of Glasgow and Sturino would still fail to cure the deficiencies of Glasgow. When compared to the configurations called for by Appellants' presented claims, the structures taught by a proper combination of Glasgow and Sturino would remain less able to be efficiently grasped by the fingers of the user's hand to fold the labial pad and to aid in the application and removal of a labial pad. Additionally, the structures taught by a proper combination of Glasgow and Sturino would continue to be less able to minimize the likelihood that the user's fingers will come into contact with the soiled, body-facing portions of a labial pad. It is, therefore, readily apparent that a proper combination of Glasgow and Sturino does not disclose or suggest Appellants' claimed invention.

It is, therefore, readily apparent that a proper combination of Glasgow and Sturino does not teach Appellants' claimed invention. Accordingly, the rejection of the claims as being unpatentable over these references should be reversed.

Grounds 3

It is respectfully submitted that Claims 6, 8, 11, 18, 20, 23, 30 32 and 36 are patentable over U.S.P. 6,613,031 to Glasgow et al. as applied to claims 1, 12 and 24, in view of U.S.P. 5,509,914 to Osborn III (Osborn). Accordingly, the Examiner's rejection under 35 U.S.C. §103 should be reversed.

A description of Glasgow and a discussion of Glasgow's shortcomings have been previously presented, and are applicable to the present argument.

Osborn describes a sanitary napkin having a body surface and a garment surface and being comprised of an absorbent means underlayed by a liquid barrier means, wherein the sanitary napkin is relatively highly flexible and has a capacity great enough to handle medium to

high menstrual flows. In a preferred embodiment, the sanitary napkin comprises, from the body surface down, an apertured formed film topsheet, an apertured nonwoven wipe acquisition sheet, a wet-laid tissue, a superabsorbent core, and a barrier sheet. Preferably, the central width of the absorbents is at least about 6.5 centimeters and the caliper of the napkin as a whole is less than about 2.6 millimeters. In a preferred embodiment, the napkin has laterally extending flaps which drape over the edges of the wearer's panties in the crotch and are attachable to the garment side of the wearer's panties.

It is readily apparent, however, that Osborn would fail to cure the deficiencies of Glasgow. A proper combination of Glasgow and Osborn would still not disclose or suggest the changes and modifications needed to synthesize the labial pad called for by Appellants' presented claims. Neither would a proper combination of Glasgow and Osborn disclose or suggest the changes needed to generate a configuration wherein at least one tab extends outward from the periphery of each of the first and second transverse end areas of the article, and each of the tabs has the configurations called for by the claimed invention.

As a result, when compared to the configurations called for by Appellants' presented claims, the structures taught by a proper combination of Glasgow and Osborn would remain less able to be grasped by the fingers of the user's hand to fold the labial pad and to aid in the application and removal of a labial pad. Additionally, the structures taught by a proper combination of Glasgow and Osborn would remain less able to minimize the likelihood that the user's fingers will come in contact with the soiled, body-facing portions of a labial pad. It is, therefore, readily apparent that a proper combination of Glasgow and Osborn would still fail to disclose or suggest Appellants' claimed invention.

It is, therefore, readily apparent that a proper combination of Glasgow and Osborn does not teach Appellants' claimed invention. Accordingly, the rejection of the claims as being unpatentable over these references should be reversed.

CONCLUSION

For the reasons set forth in the above remarks, it is respectfully submitted that the Examiner's rejections under 35 U.S.C. §103 based upon U.S.P. 6,613,031 to Glasgow et al., U.S.P. 5,713,886 to Sturino, U.S.P. 5,509,914 to Osborn III or any proper combination thereof, should be reversed. It is respectfully submitted that Appellants' claimed invention is neither expressly taught by nor inherent in the cited references. Additionally, the Examiner has not

established a prima facie case that the particular combinations of components called for by Appellants' claims would be suggested by a proper combination of the cited references. To the contrary, it is readily apparent that when each cited reference is considered in its entirety and each reference is taken as a whole, a proper combination of the cited references would not teach Appellants' claimed invention. Only in light of Appellants' present disclosure and the impermissible use of hindsight would a person of ordinary skill be directed to the significant changes and modifications needed to reconfigure the various components to arrive at Appellants' claimed invention. It is, therefore, readily apparent that the invention called for by Appellants' claims is patentable over cited references.

Accordingly, it is respectfully submitted that Claims 1, 3-12, 14-24 and 26-36 are in allowable condition, and that the Examiner's rejections should be reversed.

Respectfully submitted,
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